

1 BoxInterferences@uspto.gov
2 Telephone: 571-272-4683

Paper 42
Entered: 14 July 2008

4 UNITED STATES PATENT AND TRADEMARK OFFICE
5 BOARD OF PATENT APPEALS AND INTERFERENCES

8 Patent Interference 105,619 McK
9 Technology Center 1600

12 **BETH ISRAEL DEACONESS MEDICAL CENTER,**
13 YALE UNIVERSITY and IKARIA HOLDINGS, INC.
14 (Inventors: FRITZ H. BACH, LEO E. OTTERBEIN,
15 MIGUEL P. SOARES and JEANNE GOSE),

17 Patent 7,238,469 B2,
18 Junior Party,

20 v.

22 DAVID J. PINSKY, DAVID M. STERN
23 and CHARLES J. PRESTIGIACOME,

25 Application 10/679,135,
26 Senior Party,

29 *Before:* FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
30 RICHARD E. SCHAFER and JAMES T. MOORE, *Administrative Patent
31 Judges*.

33 McKELVEY, *Senior Administrative Patent Judge*.

35 **JUDGMENT**

36 Upon consideration of the CONCESSION OF PRIORITY TO
37 PINSKY (Paper 41 filed by the Junior Party, it is

Count 1

2 ORDERDED that judgment on priority as to Count 1 (Paper 1,
3 pages 6-7) is awarded against Junior Party BETH ISRAEL DEACONESS
4 MEDICAL CENTER, YALE UNIVERSITY, IKARIA HOLDINGS, INC.,
5 and inventors FRITZ H. BACH, LEO E. OTTERBEIN, MIGUEL P.
6 SOARES and JEANNE GOSE.

7 FURTHER ORDERED that Junior Party BETH ISRAEL
8 DEACONESS MEDICAL CENTER, YALE UNIVERSITY, IKARIA
9 HOLDINGS, INC., and inventors FRITZ H. BACH, LEO E. OTTERBEIN,
10 MIGUEL P. SOARES and JEANNE GOSE are not entitled to a patent
11 containing claims 1-14, 20-36 and 49-54 (corresponding to Count 1) of
12 U.S. Patent 7,238,469 B2, granted 03 July 2007.

13 FURTHER ORDERED that claims 1-14, 20-36 and 49-54 of
14 U.S. Patent 7,238,469 B2 are cancelled. 35 U.S.C. § 135(a).

Count 2

16 FURTHER ORDERDED that judgment on priority as to
17 Count 2 (Paper 1, page 9) is awarded against Junior Party BETH ISRAEL
18 DEACONESS MEDICAL CENTER, YALE UNIVERSITY, IKARIA
19 HOLDINGS, INC., and inventors FRITZ H. BACH, LEO E. OTTERBEIN,
20 MIGUEL P. SOARES and JEANNE GOSE.

21 FURTHER ORDERED that Junior Party BETH ISRAEL
22 DEACONESS MEDICAL CENTER, YALE UNIVERSITY, IKARIA
23 HOLDINGS, INC., and inventors FRITZ H. BACH, LEO E. OTTERBEIN,
24 MIGUEL P. SOARES and JEANNE GOSE are not entitled to a patent
25 containing claims 1-13, 16, 20-33, 40-42 and 49-54 (corresponding to
26 Count 2) of U.S. Patent 7,238,469 B2, granted 03 July 2007.

1 FURTHER ORDERED that claims 1-13, 16, 20-33, 40-42 and
2 49-54 of U.S. Patent 7,238,469 B2 are cancelled. 35 U.S.C. § 135(a).

3 Count 3

4 FURTHER ORDERDED that judgment on priority as to
5 Count 3 (Paper 1, page 10) is awarded against Junior Party BETH ISRAEL
6 DEACONESS MEDICAL CENTER, YALE UNIVERSITY, IKARIA
7 HOLDINGS, INC., and inventors FRITZ H. BACH, LEO E. OTTERBEIN,
8 MIGUEL P. SOARES and JEANNE GOSE.

9 FURTHER ORDERED that Junior Party BETH ISRAEL
10 DEACONESS MEDICAL CENTER, YALE UNIVERSITY, IKARIA
11 HOLDINGS, INC., and inventors FRITZ H. BACH, LEO E. OTTERBEIN,
12 MIGUEL P. SOARES and JEANNE GOSE are not entitled to a patent
13 containing claims 46, 49-51, 53, 56-62, 65 and 89 (corresponding to
14 Count 3) of U.S. Patent 7,238,469 B2, granted 03 July 2007.

15 FURTHER ORDERED that claims 46, 49-51, 53, 56-62, 65
16 and 89 of U.S. Patent 7,238,469 B2 are cancelled. 35 U.S.C. § 135(a).

17 Other matters

18 FURTHER ORDERED that if there is a settlement agreement,
19 attention is directed to 35 U.S.C. § 135(c).

20 FURTHER ORDERED that a copy of this JUDGMENT shall
21 be placed in the files of (1) U.S. Patent 7,238,469 B2 and (2) application
22 10/679,135.

23 FURTHER ORDERED that the Clerk is directed to distribute
24 the files upon entry of this JUDGMENT.

1 105619
2 cc (via electronic mail):
3
4 Attorney for
5 Beth Israel Deaconess Medical Center, Inc. and Yale University:
6
7 Debra A. Shetka, Esq.
8 Todd Garcia, Esq.
9 FISH & RICHARDSON P.C.
10 3300 Dain Rauscher Plaza
11 60 South Sixth Street
12 Minneapolis, MN 55402
13
14 Tel: 612-335-5070
15 Fax: 612-288-9696
16 Email: shetka@fr.com
17 Email: garcia@fr.com
18
19 Attorney for Ikaria Holdings, Inc.
20
21 Jonathan Provoost
22 Associate General Counsel
23 Intellectual Property and Regulatory
24 Ikaria Holdings, Inc.
25 6 Route 173
26 Clinton, NJ 08809
27
28 Tel: 908-238-6392 (Direct)
29 Fax: 908-238-6773
30 Email: jonathan.provoost@ikaria.com
31

1 Attorney for Pinsky
2 (real party in interest
3 The Trustees of Columbia University in the City of New York;
4 IKARIA Holdings, Inc. (licensee));
5
6 John P. White, Esq.
7 Gary J. Gershik, Esq.
8 COOPER & DUNHAM LLP
9 1185 Avenue of the Americas
10 New York, NY 10036
11
12 Tel: 212-278-0400 (main)
13 Tel: 212-278-0421 (White)
14 Fax: 212-391-0526
15 Email: jwhite@cooperdunham.com
16 Email: ggershik@cooperdunham.com
17